

## REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks and arguments included herewith.

Applicants thank the Examiner for granting the August 22, 2005 telephone interview. The Examiner said he would consider Applicants' arguments regarding rejection of the claims under 37 U.S.C. 102(e). Applicants have asserted those arguments herein below.

### I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-47 are currently pending. Claims 1, 9, 15, 23 and 28-47 are independent.

Claims 1-47 were rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. The previously submitted declaration is unsigned.

Applicants have included a signed declaration with this reply.

### II. REJECTIONS UNDER 35 U.S.C. §102

Claims 1-47 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,743,380 (the Examiner intended to refer to 5,473,380) to Tahara et al. (hereinafter, merely '380 patent). Applicants disagree.

35 U.S.C. 102 provides, in relevant part, "A person shall be entitled to a patent unless -

(e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . ." (emphasis added)

The '380 patent is not a valid 102(e) reference for at least three reasons. First, the present application is a reissue of U.S. Patent No. 5,715,009 (hereinafter, merely '009 patent). The '009

patent is a continuation-in-part (CIP) of the potential reference, the '380 patent, and claims priority thereto. Thus, both patents have the same priority date. Consequently, the '380 patent is disqualified as 102(e) prior art because that patent was not granted on an application filed before the invention of the present application.

Second, the 102(e) date of the potential reference, the '380 patent, is **March 29, 1994**, which is its earliest effective U.S. filing date. No benefit of the filing date of a foreign application is given under 102(e) for prior art purposes. The '009 patent and, hence, the reissue application are a CIP of a parent application (which, in this case, is also the '380 patent) and claim priority thereto. The reissue application gets the benefit of the filing date of the foreign application of the parent '380 parent for the subject matter described in that foreign application; and the filing date of the foreign application that purportedly describes the claimed invention (if the Examiner's contention in his rejection is correct) is **March 29, 1993**, the date on which Japanese priority application 05-069,829 was filed. A certified copy and a sworn English translation of the Japanese priority document were filed in the parent application. Consequently, the '380 patent is disqualified as 102(e) prior art because that patent was not granted on an application filed before the invention of the present application.

Third, if Applicants accept the contention, as stated in the Office Action, that the subject matter of the reissue claims is disclosed in the parent '380 patent, then that subject matter can not be by another, as required in 102(e). The subject matter of the parent '380 patent was invented by Tahara alone (Tahara is the sole patentee of the '380 patent). The '009 patent was invented by Tahara and a third party. The Office Action contends that the subject matter of the claims of the child '009 patent and the reissue application are disclosed in the parent '380 patent. If that is

the case, then only Tahara could be the one responsible for the subject matter disclosed in the parent that is claimed in the child.

It is also stated in the Office Action that claims 1-47 are anticipated by the '380 patent because the parent '380 patent and the present reissue application of the '009 patent have identical specifications. This is not correct. The '009 patent includes additional disclosure from col.17, line 33 to col. 18, line 38 and additional FIGS. 17 and 18 not found in the parent '380 patent.

Thus, the 102(e) rejection of claims 1-47 should be withdrawn. The cited '380 patent is disqualified as prior art with respect to the present application because the '380 patent was not granted on an application filed before the invention of the present application. Alternatively, it logically follows that any disclosure in the parent '380 patent that is claimed in the present '009 reissue application was invented by the same entity.

## II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 28-47 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,537,440 to Eyuboglu et al. (hereinafter, merely "Eyuboglu") in view of U.S. Patent No. 5,563,593 to Puri. (hereinafter, merely "Puri").

Independent claim 28 recites, *inter alia*:

An encoding apparatus for encoding source video data which had previously been encoded at a previous encoding process and had previously been decoded at a previous decoding process, said apparatus comprising:

...  
means for extracting coding information from said source video data, wherein said coding information relates to a coding operation of said previous encoding process, ...

means for encoding said source video data in accordance with said coding information.

As understood by the Applicants, Eyuboglu discloses a transcoder for transcoding of digitally encoded bit streams produced by predictive encoders. The transcoder combines decoding and re-encoding steps into one step. A transcoder translates compressed image data from one format to another.

Eyugoblu does not teach or suggest in the disclosure or Figures that more than one encode/decode (codec) operation is required. The Office Action points to FIG. 3 for the element, “encoding source video data which had previously been encoded at a previous encoding process and had previously been decoded at a previous decoding process.” Applicants respectfully disagree. In FIG. 3, the input of the transcoder (304) is a bit stream generated by a predictive waveform encoder (302). The output is another bit stream which is decoded by a predictive waveform decoder (306). The transcoder (304) modifies the bit stream according to a predetermined objective. Col. 4, lines 17-24. FIG. 3 does not disclose that the input data (supplied to encoder 302) has been previously subjected to a codec operation. Indeed, there is no previous encoder and decoder mentioned, suggested or disclosed in Eyogblu at all.

Further, the Office Action points to FIG 10 for the element that the coding information of the source data relates to a previous coding operation. This is a misinterpretation of FIG. 10, which, again, only discloses a single decode and encode operation. FIG. 10 merely shows additional operations associated with Eyugoblu’s transcoder disclosed, for example, in FIG. 7: Col. 9, lines 20-35.

In contrast, in the present application, each picture of a picture signal is encoded as a function of a respective picture type, then appropriately decoded. The decoded picture signal

includes the respective picture types. When the pictures of the decoded picture signal are again encoded, the re-encoding is a function of the picture type included in the decoded picture signal. The re-encoded signal includes the picture type. Subsequent decoding of the re-encoded picture is a function of the picture type. Each picture of the re-decoded picture signal includes its respective picture type. Thus, the present invention matches the type of predictive coding applied to pictures in a picture signal by serially arranged coders that process the picture signal. Hence, the encode/decode operation is applied to input data that includes coding information from a previous serially arranged coder. The coding information can only come from having undergone the previous codec operation. There is no suggestion or teaching in Eyuboglu that there is more than one encode/decode operation and that subsequent codec operations operate on input video data that includes additional coding information resultant from the previous codec operation.

The disclosure of Puri does not add the element missing from Eyugoblu. Thus, neither Eyugoblu nor Puri either alone or in combination teach or suggest each and every element recited in claim 28. In particular, the references do not teach or suggest, “an encoding apparatus for encoding source video data which had previously been encoded at a previous encoding process and had previously been decoded at a previous decoding process . . . means for extracting coding information from said source video data, wherein said coding information relates to a coding operation of said previous encoding process, . . . and

means for encoding said source video data in accordance with said coding information.”

For reasons similar or somewhat similar to those described above with regard to independent claim 28, independent claims 29-47 are also believed to be patentable.

### III. DEPENDENT CLAIMS

None of the dependent claims were rejected as being unpatentable over Eyugoblu in view of Puri. Hence, further discussion of the dependent claims is not needed.

### CONCLUSION

Claims 1-47 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

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In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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